

**Remarks**

**Status of the Application**

In the Office Action, the Examiner indicated formal drawings will be required when the application is allowed. The Examiner also rejected claim 7 under 35 U.S.C. §112 as being indefinite and rejected claims 1 and 3-8 under 35 U.S.C. §103(a) as being unpatentable over the article *How Avery Dennison Manages Its Intellectual Assets* by Germraad et al. (hereinafter "Germraad") in view of United States Patent No. 6,539,403 to Cho et al. (hereinafter "Cho").

**In the Drawings**

Applicants recognize, as the Examiner has indicated, that formal drawings will be required when the application is allowed.

**In the Claims**

Applicants have amended claims 1 and 3-8 herein to clarify the subject matter of those claims.

**Rejections under 35 U.S.C. §112**

Applicants have also amended claim 7 herein to overcome the rejection under 35 U.S.C. §112.

**Rejections under 35 U.S.C. §103(a)**

**The Reference Relied Upon**

Germraad discloses seven tools for managing intellectual assets that are said to (i) capture ideas as intellectual assets; (ii) screen ideas for inclusion in an R&D portfolio; (iii) use knowledge of intellectual property opportunities to prioritize programs; (iv) ensure just-in-time intellectual property protection; (v) determine what type of intellectual property protection is most appropriate to use

as an idea goes commercial; (vi) audit families of intellectual property for their continuing value; and (vii) communicate strong and weak areas of core competency protection. See page 36, column 2. Germeraad also discloses capture of ideas and additional information on the concept in a searchable, recorded database in the first column of what appears to be page 37. Germeraad suggests the use of a Strategic Planning Sheet shown in Figure 1, a database, a spider diagram or spider map shown in Table 2, a Strategic Fit vs. Reward map shown in Figure 2, matrix maps shown in Figure 3, funnel maps shown in figure 4, a 2x2 intellectual asset map shown in Figure 5, a Nesté corporation model shown in figure 6, a patent spreadsheet illustrated in Figure 7 that is said to be shared across the corporation, and a Corporate Health Pyramid shown in Figure 8.

Cho discloses a spread-sheet based method and system for facilitating information exchange over the Internet. See column 1, lines 14-22. Cho further states the method and system of the Cho invention provides a web-based financial services utility that combines the benefits of a centralized data and document repository with distributed spreadsheet technology and leverages the infrastructure of the Internet at column 4, lines 12-23.

In its background, Cho discloses that the failure to integrate a budget into day-to-day operations causes, among other things, unfulfilled recognition of the interdependence of R&D expenditure to legal expenses for patent procurement in column 2, at lines 38-51.

Cho further discloses a browser that links information in cells to documents in an enterprise source, e.g., spreadsheets, work processing documents, Power Point presentations, video files, and sound files or to external sources of information located on the Internet, e.g., news stories, analyst reports, and publications at column 7 lines 22-30. Cho continues stating “[t]he ability to connect ancillary sources of information with communications associates with the

budgeting process afforded by the method/system of the present disclosure significantly improves... the budgeting process" at lines 30-34. Cho goes on to suggest the ancillary information may be directly associated with a specific aspect of a budget related submission using hyperlinks at lines 35-39.

Cho also discloses use of a data cache that automatically caches data input at the client or retrieved to the client from a database or enterprise source for access to obtain previously cached data so that data in the cache need not be retrieved across the network. See column 10, lines 21-35. Cho goes on to disclose a "key cache" that automatically checks internally for each piece of data requested by the spreadsheet and provides such data to the spreadsheet at lines 36-54.

#### Analysis in Light of the Obviousness Rejection Standards

The Examiner based the combination of Germeraad and Cho on "[b]oth Germeraad and Cho [being] concerned with the problem of managing information."

Section 2143.01 of the *Manual of Patent Examining Procedure*, provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>1</sup>

While Cho suggests that integration of a budget into day-to-day operations could cause recognition of the interdependence of R&D expenditure to legal expenses for patent procurement, Applicants submit that Cho does not suggest the desirability of combining its web-based financial services utility that combines the benefits of a centralized data and document repository with distributed spreadsheet technology with any innovation database system. Germeraad suggests the use of a Strategic Planning Sheet, a database, a spider diagram, a Strategic Fit vs. Reward map, matrix maps, funnel maps, a 2x2 intellectual asset map, a Nesté corporation model, a patent spreadsheet, and a Corporate Health

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<sup>1</sup> MPEP § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Pyramid. None of those tools, however, appears to include or be a financial services utility that combines the benefits of a centralized data and document repository with distributed spreadsheet technology. Accordingly, Applicants submit claims 1 and 3-8 are patentable over the cited references because there is no suggestion of the desirability of the combination of the Cho and Germeraad references in the prior art

Section 2143.03 of the *Manual of Patent Examining Procedure*, provides:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.<sup>2</sup>

Amended claim 1 recites, *inter alia*, a system that summarizes company innovations, uses intelligent agents to automatically perform searches on the Internet to find competing ideas, and generates reports which list potential competitive strengths or weaknesses of the innovations.

Applicants submit that Germeraad discloses tools for integrating technology and business strategies, but Germeraad does not disclose summarizing company innovations. Applicants submit that Cho also does not disclose summarizing company innovations.

Applicants further submit that neither Germeraad nor Cho discloses anything related to using intelligent agents to automatically perform searches on the Internet to find competing ideas.

Applicants also recognize that Germeraad discloses a tool to communicate strong and weak areas of core competency protection that is apparently illustrated in Figure 8. Applicants submit, however, that Germeraad does not disclose generating reports which list potential competitive strengths or weaknesses of innovations. Rather, Germeraad discloses communication of a level of protection. Applicants also submit that Cho does not disclose anything

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<sup>2</sup> MPEP § 2143.01, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

related to generating reports which list potential competitive strengths or weaknesses of innovations.

Thus, Applicants further submit claim 1 is patentable over the cited references because the cited references do not teach or suggest all of the limitations of claim 1. Furthermore, claims 3-5, 7 and 8 are seen to be patentable because they depend from claim 1.

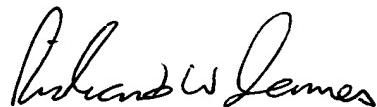
Amended claim 6 recites, *inter alia*, a system that performs at least one of identifying, classifying, compiling, tracking, and routing real-time innovation data automatically on a continuous basis. Applicants submit that neither Germeraad nor Cho disclose identifying, classifying, compiling, tracking or routing real-time innovation data automatically on a continuous basis. Thus, Applicants further submit claim 6 is patentable over the cited references because the cited references do not teach or suggest all of the limitations of claim 6.

### **Conclusion**

Applicants respectfully submit that claims 1 and 3-8 as amended herein are in condition for allowance. Applicants also submit that no new matter has been introduced in the amendments presented herein. Accordingly, reconsideration of the present objections and rejections and passage to allowance of claims 1 and 3-8 at an early date are earnestly solicited.

If the Examiner is of the opinion that the Subject Application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact Applicants' Attorney at the telephone number listed below so that any concerns may be expeditiously addressed.

Respectfully Submitted



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